

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION

QUINTAL RESEARCH GROUP, INC.

Plaintiff,

vs.

NINTENDO OF AMERICA, INC. and
NINTENDO COMPANY LTD.,

Defendants.

Case No: C 13-00888 SBA

**ORDER GRANTING
DEFENDANTS' MOTION FOR
SUMMARY JUDGMENT OF
NONINFRINGEMENT**

Docket 45

Quintal Research Group, Inc. ("Plaintiff" or "Quintal"), the owner of United States Patent No. 7,425,944 ("944 Patent"), brings the instant patent infringement action against Defendants Nintendo of America, Inc., and Nintendo Company Ltd. (collectively "Defendants" or "Nintendo"). Quintal alleges that certain of Nintendo's Game Boy handheld gaming devices infringe the '944 Patent, inter alia, with respect to the location of their thumb-activated controls. The Court has jurisdiction over the action pursuant to 28 U.S.C. § 1338(a).

The parties are presently before the Court on Nintendo's Motion for Summary Judgment of Noninfringement. Having read and considered the papers filed in connection with this matter and being fully informed, the Court hereby GRANTS Nintendo's motion for the reasons set forth below. The Court, in its discretion, finds this matter suitable for resolution without oral argument. See Fed. R. Civ. P. 78(b); N.D. Cal. Civ. L.R. 7-1(b).

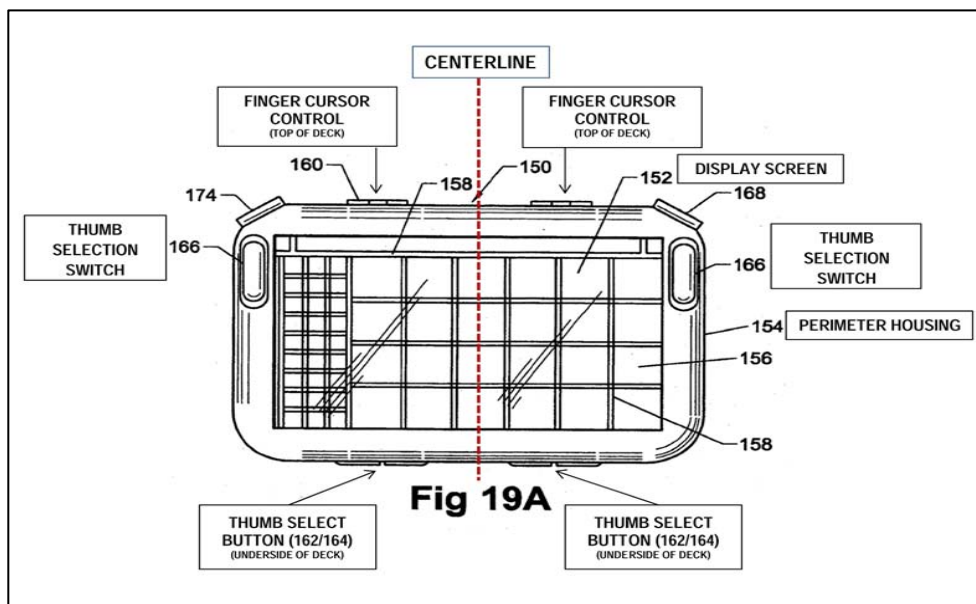
I. BACKGROUND

A. SUMMARY OF THE '944 PATENT

1. Overview

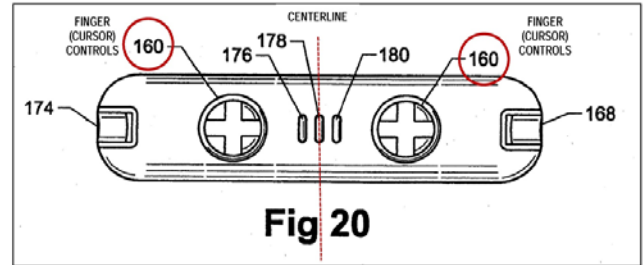
Quintal is the owner of the '944 Patent, entitled "Computerized Information Retrieval System," which was assigned from its inventor and patent attorney, Richard Peterson. The Abstract describes the invention as "a portable handheld communication device for rapid retrieval of computerized information[.]" First Am. Compl. ("FAC"), Ex. 1 ("944 Patent"), Dkt. 13-1. The communication device or "microdeck" is designed to "interconnect with network computer consoles or communication systems for access to a larger data net" and to "optimize data input and output without the use of a keyboard," *Id.*, col. 3 ll. 43-46, col. 5 ll. 7-9 & 20-25, col. 6 ll. 18-23.

The microdeck is the size of a deck of cards, "having a generally rectangular shape with a display screen [152] on one side that has a frame with ergonomic placement of finger controls [160] including a pair of thumb controls on either side of the screen [166] with a pair of finger controls on the top of the display with a least one of the finger controls being a cursor or pointer control." '944 Patent, Abstract. In addition, there are a pair of thumb select buttons [162/164] on the underside of the microdeck that perform the same function as the thumb controls on the face of the device. As shown below in Fig. 19A



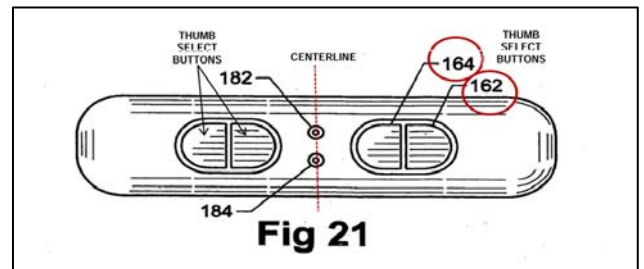
(annotated) to the '944 Patent, the controls, buttons and switches on the left and right side of the centerline of the display are mirror images of one another.

The layout of the microdeck is intended “to maximize the area of the display screen” through the “ergonomic arrangement of finger controls around the perimeter of the housing.” *Id.*, col. 5, ll. 50-53; col. 6 ll. 18-23. The specification teaches that “[t]he perimeter controls are symmetrically arranged on each side of the center line of the display screen and the principal controls are operated either redundantly or in tandem.” *Id.* col. 6 ll. 18-23. The finger controls [160] are described as a “pair of spaced cursor controls which control a single cursor (or pointer) . . . when in redundant mode, and a pair of cursors, each independently controllable when operated in tandem mode.” *Id.*, col. 6 ll. 24-28. A top view of the microdeck showing the two cursor controls is shown in Fig. 20



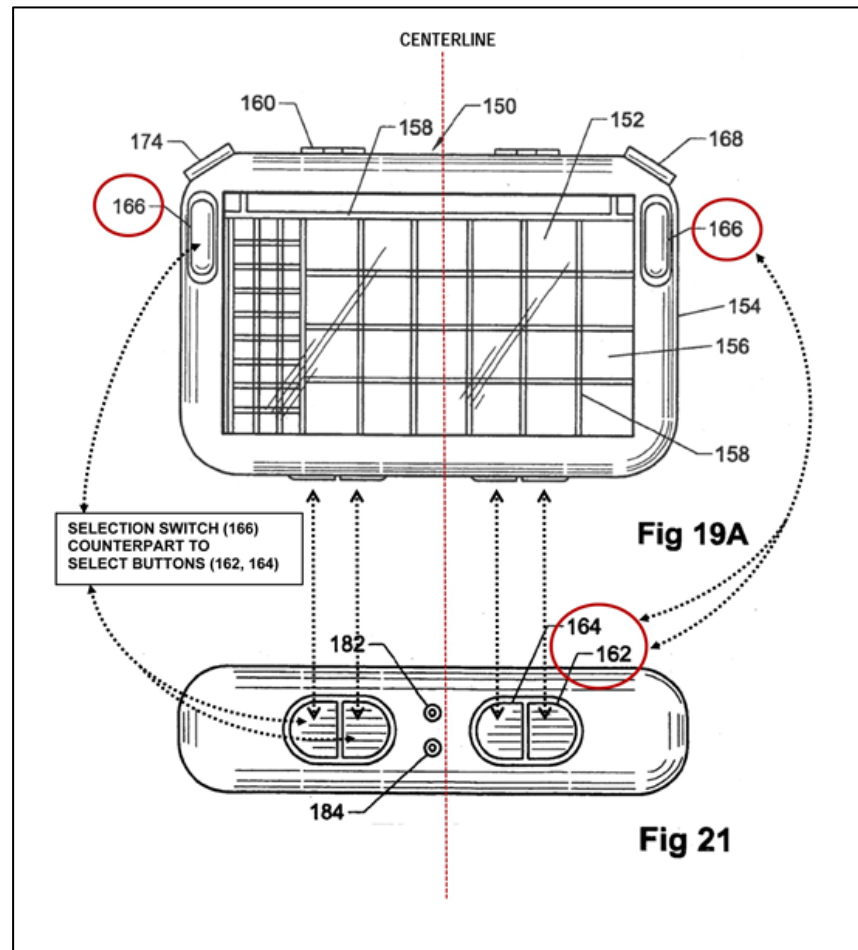
(annotated) to the '944 Patent.

In conjunction with the top-mounted cursor controls, the specification calls for a pair of thumb-controlled “select buttons” [162/164] on the underside of the microdeck, as shown in Fig. 21 (annotated) to the '944 Patent. The select buttons “correspond to the A and B mouse select buttons commonly used in a conventional mouse control.” *Id.*, col. 6 ll. 37-42. For the convenience of the user, the select buttons are replicated on the face of the microdeck as “redundant” thumb-operated controls [166] located on each side of the display screen. *Id.*, col. 6 ll. 49-52.



These counterparts—referred to as “selection switches”—permit the user to perform the same function as the select buttons by using his thumb to operate rocker (i.e., toggle) switches. *Id.*, col. 6 ll. 50-55. The forward rocker contact corresponds to the A mouse select button and the backward rocker contact corresponds to the B mouse select button. *Id.*, col. 6 ll. 55-59. The thumb controls must operate “both in a redundant mode and in a

tandem mode.” *Id.*, col. 6 ll. 39-43. The relationship between the thumb select buttons on the underside of the microdeck and their corresponding thumb selection switches on the face of the device is shown in Figs. 19A and 21 (annotated and modified), as depicted below.



2. Patent Claims

The '944 Patent has two independent claims—Claims 1 and 9—both of which are at issue in this motion. Claim 1 recites:

1. A handheld microdeck having input controls for game playing and data management comprising:
 - a rectangular display screen;
 - a perimeter housing wherein the rectangular display screen is mounted in the perimeter housing, the perimeter housing having a back panel wherein a pocket-size unit is formed having a front with the display screen,

1 a back with the back panel, a top, a bottom and two sides
2 connecting the top and bottom; and,

3 a plurality of **ergonomic manual controls** for operating
4 the microdeck wherein the manual controls are mounted
5 on the perimeter housing with two spaced finger controls
6 mounted on the top of the pocket-size unit and **two**
7 **spaced thumb controls mounted on the front of the**
pocket-size unit on each side of the screen wherein at
least one of the manual controls is a cursor control,
wherein the two spaced finger controls and **two spaced**
thumb controls are symmetrically arranged on each
side of the display screen.

8 Id., col. 18 ll. 10-28 (emphasis added). Claim 9 is identical to Claim 1, but specifies that at
9 least one of the manual controls is “a pointer,” rather than a “cursor control.” Id., col. 18 ll.
10 49-67. Both claims include the “symmetrically arranged” limitation, which lies at the
11 center of the instant controversy.

12 B. PROSECUTION HISTORY

13 The ‘944 Patent descends from U.S. Patent No. 5,452,468 (“‘468 Patent”), filed on
14 July 31, 1991. See Martinez Decl., Ex. 1 (“‘468 Patent”), col. 1 ll. 7-8, Dkt. 50-1. The
15 preferred embodiment of the invention includes a “portable, personal deck” that is a
16 “miniature operational personal computer.” Id., col. 5 ll. 5, 27-26.

17 On February 4, 1994, the inventor, Richard Peterson, filed for a continuation-in-part
18 to the ‘468 Patent, which was granted as U.S. Patent No. 6,643,656 (“‘656 Patent”). The
19 ‘656 Patent added the embodiment of a “deck,” that, unlike the parent ‘468 Patent, specifies
20 the use of finger controls. This embodiment also appears in the ‘944 Patent—the patent-in-
21 suit.

22 On July 1, 2005, the inventor filed an application for the ‘944 Patent. See U.S.
23 Patent Appl. No. 11/173,330. During the patent prosecution process, the patent examiner
24 added the “symmetrically arranged” limitation, ostensibly due to concerns regarding its
25 patentability based on the prior art. Specifically, on June 8, 2008, the patent examiner
26 conducted a telephone interview with the inventor in connection with his submission for a
27
28

1 terminal disclaimer.¹ Hamilton Decl., Ex. B (‘944 Patent File History, June 17, 2008,
2 Notice of Allowance), Dkt. 45-7. During their conversation, the inventor authorized the
3 examiner to amend Claims 1 and 9 by adding the limitation, “wherein the two spaced finger
4 controls and two spaced thumb controls are symmetrically arranged on each side on the
5 display screen.” Id. at 6 (emphasis added).

6 On June 17, 2008, the examiner, upon obtaining the inventor’s consent to his
7 proposed addition of the “symmetrically arranged” limitation, issued a Notice of
8 Allowance, indicating the intent of the Patent and Trademark Office (“PTO”) to issue the
9 patent and allow Claims 1 through 16. Id. at 1. In the section entitled “Allowable Subject
10 Matter,” the examiner stated that “Claims 1-16 are allowed since key features of the
11 claimed invention are not taught or fairly suggested by prior art.” Id. at 7. The examiner
12 explained that the “closest prior art Matthews (5,432,510) teaches [a] data input device
13 [that] includes an ergonomic arrangement of keys on [a] casing”—but that Matthews,
14 whether considered individually or in combination of other prior art, did not read on the
15 specified limitations, as amended by the examiner. Id.

16 On July 31, 2008, the inventor submitted Amendment After Allowance Under 37
17 C.F.R. § 1.312 (“Amendment After Allowance”) to the PTO to address alleged errors by
18 the patent examiner in the Notice of Allowance. Hamilton Decl., Ex. C, Dkt. 45-8 at 1-2.
19 The claim language, as modified by the examiner, read as follows: “

20 [W]herein the two finger spaced controls and two spaced thumb
21 controls are symmetrically arranged on each side on the display
screen--.

22 Id. at 2 (emphasis added). The inventor proposed amending the above claim language to
23 instead state as follows (as denoted by the underline and strikeout):

24 _____
25 ¹ A patent term is limited to twenty years. 35 U.S.C. § 154(a)(2). A terminal
26 disclaimer is a statement that the patentee can make to limit the patent term in order to
27 allow a subsequent patent to issue based on essentially the same subject matter as an earlier
28 patent. See Manual of Patent Examining Procedure § 804.02. The terminal disclaimer
means that the patentee agrees that the second patent will expire on the same date as the
prior patent, thereby avoiding double-patenting rejection. Id. All of the patents in the
family originating with the ‘468 Patent, including the ‘944 Patent, were subject to an
automatic terminal disclaimer and expired on July 31, 2011.

[W]herein the two finger spaced controls and two spaced thumb controls are symmetrically arranged on each side of the centerline of ~~on~~ the display screen--.

Id. (alterations in orig.). The inventor claimed that the examiner's use of "on" as opposed to "in" was a "transcription error," as evidenced by the fact that the examiner properly used "of" elsewhere in the Notice of Allowance. Id. at 5. With regard to the addition "of the centerline," the inventor stated:

To clarify what was intended and understood by Applicant and Examiner, Applicant corrects the error and adds the clarifying term, "of the centerline." This conforms the claim terminology to the specification language, page 13, lines 14-16, where it is stated, "The perimeter controls are symmetrically arranged on each side of the centerline of the display screen . . ." This also more accurately describes the locational symmetry of the two spaced finger controls mounted on the top of the unit as shown in the drawings.

Id. On September 16, 2008, the PTO issued the '944 Patent, with Claims 1 and 9 reciting the limitation, "wherein the two finger spaced controls and two spaced thumb controls are symmetrically arranged on each side of the display screen." '944 Patent, col. 18 ll. 26-28. The examiner apparently did not add the "of the centerline" to the claim language of the patent, as the inventor had requested.

C. PROCEDURAL HISTORY

Quintal commenced the instant action in this Court against Nintendo on February 27, 2013. Dkt. 1. On May 8, 2013, Quintal filed a First Amended Complaint, which alleges a single claim for patent infringement, pursuant to 35 U.S.C. § 271. Dkt. 13. In particular, Quintal claims that Nintendo's "Game Boy Advance" and "Game Boy Dual Screen," as depicted below, infringe independent Claims 1 and 9 and dependent claims 2 and 10 of the '944 Patent, either literally or under the doctrine of equivalents. FAC ¶¶ 12-17.

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Id. ¶ 12. Quintal also avers that Nintendo induced its customers to infringe the patent-in-suit. Id. ¶ 18.

Nintendo now moves for summary judgment of noninfringement. In its motion, Nintendo argues that the ordinary meaning of “symmetrically arranged” is “mirror image,” such that the two thumb controls specified in Claims 1 and 9 must correspond in size, shape, and position on each side of the display screen of the handheld deck.² Quintal counters that “symmetrically arranged” does not mean “mirror image,” and only requires that the buttons on the device be symmetrical from a “locational” standpoint—not that the identical buttons be placed in the exact same position on either side of the display screen. Alternatively, Nintendo contends that even under Quintal’s construction, Quintal cannot show that Nintendo’s accused devices have one thumb control on one side of the display screen that is symmetrical to a thumb control on the other, as required by the ‘944 Patent.

II. LEGAL STANDARD

Under Federal Rule of Civil Procedure 56, “summary judgment is appropriate where there ‘is no genuine issue as to any material fact’ and the moving party is ‘entitled to a judgment as a matter of law.’” Alabama v. North Carolina, 560 U.S. 330, 344 (2010) (quoting Fed. Rule Civ. Proc. 56(c)) (citing cases). “The burden of establishing the nonexistence of a ‘genuine issue’ is on the party moving for summary judgment.” Celotex

² Although the ‘944 Patent refers to two finger controls and two thumb controls, Nintendo’s motion focuses on the lack of two “symmetrically arranged” thumb controls as the basis for noninfringement.

1 Corp. v. Catrett, 477 U.S. 317, 330 (1986). The movant must inform the district court “of
 2 the basis for its motion, and identifying those portions of ‘the pleadings, depositions,
 3 answers to interrogatories, and admissions on file, together with the affidavits, if any,’
 4 which it believes demonstrate the absence of a genuine issue of material fact.” Id.

5 Where the moving party meets its initial burden, the burden then shifts to the non-
 6 moving party to designate specific facts demonstrating the existence of a genuine issue of
 7 material fact. Id. at 324. “This burden is not a light one. The non-moving party must show
 8 more than the mere existence of a scintilla of evidence.” In re Oracle Corp. Secs. Litig.,
 9 627 F.3d 376, 387 (9th Cir. 2010) (citing Anderson v. Liberty Lobby, Inc., 477 U.S. 242,
 10 252 (1986)). An issue is “genuine” only if there is sufficient evidence for a reasonable fact
 11 finder to find for the non-moving party. See Anderson, 477 U.S. at 322-23. All reasonable
 12 inferences are to be drawn in favor of the party against whom summary judgment is sought.
 13 Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 587 (1986).

14 **III. DISCUSSION**

15 “A determination of patent infringement consists of two steps: (1) the court must
 16 first interpret the claim, and (2) it must then compare the properly construed claims to the
 17 allegedly infringing device.” Playtex Prods., Inc. v. Procter & Gamble Co., 400 F.3d 901,
 18 905-906 (Fed. Cir. 2005). The Court discusses each issue, in turn.

19 **A. CLAIM CONSTRUCTION**

20 Claim construction presents a question of law. See Markman v. Westview
 21 Instruments, Inc., 517 U.S. 370, 372 (1996). Claim terms are generally given their ordinary
 22 and customary meaning, which “is the meaning that the term would have to a person of
 23 ordinary skill in the art in question at the time of the invention.” Phillips v. AWH Corp.,
 24 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). In construing a disputed claim term,
 25 courts first look to the patent’s intrinsic evidence, which consists of its claim language,
 26 specification, and prosecution history. Nautilus, Inc. v. Biosig Instruments, Inc., 134 S.Ct.
 27 2120, 2127 (2014). The specification is the “single best guide” for construing disputed
 28 claim terms. Phillips, 415 F.3d at 1315. A court also may appropriately consult the

1 description of the preferred embodiment, Pandrol USA, LP v. Airboss Ry. Prods., Inc., 320
2 F.3d 1354, 1363 n.1 (Fed. Cir. 2003) (citations omitted), but “must not to import limitations
3 into the claims from the specification,” Trading Techs. Int’l, Inc. v. eSpeed, Inc., 595 F.3d
4 1340, 1352 (Fed. Cir. 2010).

5 “In most situations, an analysis of the intrinsic evidence alone will resolve any
6 ambiguity in a disputed claim term. In such circumstances, it is improper to rely on
7 extrinsic evidence.” Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583 (Fed. Cir.
8 1996). Extrinsic evidence may thus be considered only if necessary to assist the court in
9 determining the meaning or scope of technical claim terms. Id. Extrinsic evidence
10 “consists of all evidence external to the patent and prosecution history, including expert and
11 inventor testimony, dictionaries, and learned treatises.” Phillips, 415 F.3d at 1317. Courts
12 should not rely on extrinsic evidence in claim construction to contradict the meaning of
13 claims that can be discerned from examination of the claims, the written description, and
14 the prosecution history. See Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298,
15 1308 (Fed. Cir. 1999) (citing Vitronics, 90 F.3d at 1583).

16 1. Intrinsic Evidence

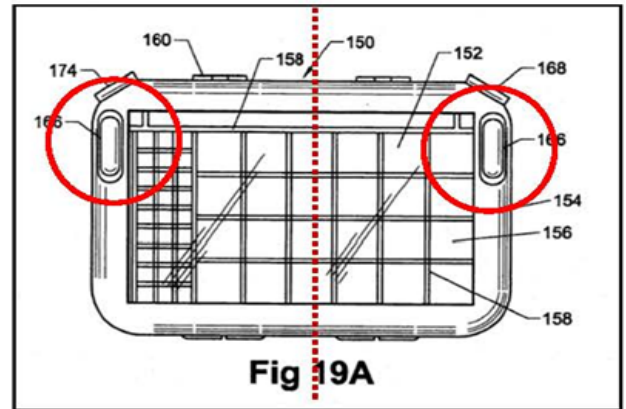
17 Claims 1 and 9 both specify the use of “multiple ergonomic manual controls,”
18 consisting of “two spaced finger controls and two spaced thumb controls [that] are
19 symmetrically arranged on each side of the display screen.” ‘944 Patent, col. 18 ll. 26-28.
20 Although “symmetrically arranged” is not defined in the claims, the specification explains
21 that the two thumb controls (i.e., selection switches) are to correspond and function
22 identically to the thumb controls located on the underside of the deck (i.e., select buttons).
23 ‘944 Patent, col. 6 ll. 36-42, 49-59. Each thumb control is a rocker switch intended to
24 correlate to the A and B mouse buttons, which must operate “both in a redundant mode and
25 in a tandem mode.” Id., col. 6 ll. 39-43. Because the ‘944 Patent explicitly teaches the use
26 of only two thumb controls on the face of the deck and requires that the thumb control on
27 one side of the display must be redundant of control on the other side, one skilled in the art,
28

reading the specification, would understand that “symmetrically arranged” thumb controls means that the controls are to be mirror images of one another.

The above conclusion is further supported by the depiction of the preferred embodiment in Fig. 19A, which shows that the thumb controls are identical in size, shape and location on either side of the display

screen. Quintal contends that by pointing to Fig. 19A of the ‘944 patent to support its argument, Nintendo is impermissibly attempting to import limitation from the preferred embodiment into the claims. Pl.’s

Opp’n, Dkt. 49 at 19-20. The Court



disagrees. As discussed above, the specification’s statements regarding the purpose and intent of the two thumb controls support the conclusion that Claims 1 and 9 teaches that each thumb control on either side of the display must mirror one another. Fig. 19A merely confirms this.

Notwithstanding the foregoing, Quintal insists that “symmetrically arranged” only requires symmetry in the location of the controls. Pl.’s Opp’n, Dkt. 49 at 6. While this interpretation may have some facial appeal, it is predicated solely on extrinsic evidence. The Federal Circuit has made clear that a proposed claim construction that is untethered to the patent’s claims, specification and other intrinsic evidence, is untenable. See Raylon, LLC v. Complus Data Innovations, Inc., 700 F.3d 1361, 1369 (Fed. Cir. 2012) (holding that a proposed claim construction that was unsupported by intrinsic evidence was frivolous and warranted Rule 11 sanctions); Medrad, Inc. v. MRI Devices Corp., 401 F.3d 1313, 1319 (Fed. Cir. 2005) (“We cannot look at the ordinary meaning of the term . . . in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description and the prosecution history.”); see also Hologic, Inc. v. SenoRx, Inc., 639 F.3d 1329, 1338 (Fed. Cir. 2011) (holding that the district court properly referred the patent specification in

1 construing the disputed claim). For these reasons, the Court finds Quintal’s proposed
 2 construction of “symmetrically arranged” is untenable.³

3 2. **Extrinsic Evidence**

4 Where, as here, the intrinsic evidence supports a proposed construction of a disputed
 5 claim term, there is no need to resort to extrinsic evidence. Interval Licensing LLC v.
 6 AOL, Inc., 766 F.3d 1364 n.6 (Fed. Cir. 2014). But even if the consideration of extrinsic
 7 evidence were necessary, the Court finds that such evidence supports Nintendo’s
 8 construction of “symmetrically arranged.”

9 a) **Dictionaries**

10 The Federal Circuit has “made clear that dictionaries and treatises can often be
 11 useful in claim construction, particularly insofar as they help the court to better understand
 12 the underlying technology and the way in which one of skill in the art might use the claim
 13 terms.” Starhome GmbH v. AT & T Mobility LLC, 743 F.3d 849, 856 (Fed. Cir. 2014)
 14 (internal quotations omitted). In doing so, the court must be careful not to consult a
 15 definition that contradicts “any definition found in or ascertained by a reading of the patent
 16 documents.” Phillips, 415 F.3d at 1322-23. In addition, “[t]he court must ensure that any
 17 reliance on dictionaries accords with the intrinsic evidence: the claims themselves, the
 18 specification, and the prosecution history.” Free Motion Fitness, Inc. v. Cybex Int’l, Inc.,
 19 423 F.3d 1343, 1348 (Fed. Cir. 2005).

20 Dictionaries published during the relevant time period consistently define
 21 “symmetry” to mean “correspondence in size, shape, and position of parts that are on
 22 opposite sides of a dividing line or center.” Hamilton Decl., Ex. D, Dkt. 45-9 (Webster’s
 23 Illustrated Dictionary 519 (2d ed. 1994)); see also id. Ex. E (Random House Webster’s
 24 Dictionary 669 (1993), defining “symmetry” as “correspondence in size, form, and
 25 arrangement of parts on opposite sides of a plane, line, or point”); id. (Webster’s Third New
 26

27 ³ Nintendo’s motion briefly cites the ‘468 Patent’s use of the term “symmetrically
 28 arranged” in relation to computer memory architecture to support its construction of that
 term in the context of the ‘944 Patent. The Court finds unnecessary to reach this contention
 in light of the claim language and specification.

1 International Dictionary 2317 (1993), defining “symmetry” as “the property of being
2 symmetrical; esp: correspondence in size, shape, and relative position of parts that are on
3 opposite sides of a dividing line or median plane or that are distributed about a center or
4 axis.”); id. (Webster’s Ninth New Collegiate Dictionary 1196 (1991), defining “symmetry”
5 as “the property of being symmetrical; esp: correspondence in size, shape, and relative
6 position of parts on opposite sides of a dividing line or median plane or about a center or
7 axis.”); id. (American Heritage Dictionary 1231 (3d ed. 1991), defining “symmetry” as “a
8 relationship of characteristic correspondence, equivalence, or identity among constituents
9 of a system or between different systems” or “correspondence of form and arrangement of
10 parts on opposite sides of a boundary, such as a plane or line or around a point or axis.”).

11 Quintal does not dispute that dictionaries may be consulted to construe claim terms
12 or that the definitions cited by Nintendo support a “mirror image” construction. However,
13 Quintal asserts that Nintendo is relying “solely” on them for its proposed claim
14 construction, has “cherry-picked” its definitions, and that its analysis is “divorced from the
15 intrinsic evidence.” Pl.’s Opp’n, Dkt. 49 at 18. This contention lacks merit. As discussed
16 above, the principal basis for Nintendo’s proposed construction is the language of the
17 claims and specification. Despite Quintal’s assertions to the contrary, Nintendo does not
18 rely on dictionaries in isolation, but merely cites them to confirm the ordinary meaning of
19 the disputed claim language. Quintal’s ancillary assertion that Nintendo “cherry-picked” its
20 definitions is unfounded, as Nintendo identified multiple dictionaries, all of which
21 consistently support the conclusion that the plain meaning of “symmetrically arranged”
22 incorporates correspondence in size, shape, and position on each side of a dividing line —
23 exactly as the specification does.

24 Quintal cites Merriam-Webster’s Collegiate Dictionary’s definition of
25 “symmetrical” which defines the term as “capable of division by a longitudinal plane into
26 similar halves” or “having the same number of members in each whorl of floral leaves.”
27 Dkt. 49 at 19 (citing Martinez Decl. Ex. 7, Dkt. 51-1 (Merriam-Webster’s Collegiate
28 Dictionary 10th ed. (1993))). Yet, in the same dictionary, the term “symmetry” is defined as

1 “the property of being symmetrical, esp; correspondence in size, shape and relative position
2 of parts on opposite sides of a dividing or median plane or about a center of axis.” *Id.* In
3 any event, Quintal’s proffered dictionary definitions are unhelpful because no nexus has
4 been established between those definitions and the intrinsic evidence. *Free Motion Fitness*,
5 423 F.3d at 1348. ⁴

6 *b) Nintendo’s Patent Applications*

7 Next, Quintal asserts that Nintendo’s own patent applications filed in 2010 and 2011
8 demonstrate that a person ordinarily skilled in the art would construe “symmetrically
9 arranged” as referring only to the location of the controls—and not require that the controls
10 also be the same size and shape. Pl.’s Opp’n, Dkt. 49 at 13-15. As noted, “the ordinary
11 and customary meaning of a claim term is the meaning that the term would have to a person
12 of ordinary skill in the art in question at the time of the invention, i.e., as of the effective
13 filing date of the patent application.” *Phillips*, 415 F.3d at 1312-13. In this case, the patent
14 applications cited by Quintal were filed more than nine years after the effective date of the
15 ‘944 Patent.⁵ As such, they have no bearing on what a person of ordinary skill would have
16 understood at the time of the invention.

17 Even if they were germane, the Nintendo patent applications are distinguishable.
18 The Nintendo applications disclose the placement of groups of buttons that are symmetrical
19 with respect to another component. *See* U.S. Patent App. No. (“App. No.”) 13/049,581,
20 Dkt. # 50-3 ¶ [0078] (four buttons are “bilaterally symmetrical in position” with respect to
21 analog stick); App. No. 13/153,784, Dkt. 52-7 at ¶ [0094] (same); App. No. 13/238,535,
22 Dkt. 50-4 ¶ [0095] (four buttons and analog stick are “positioned so as to be symmetrical”);

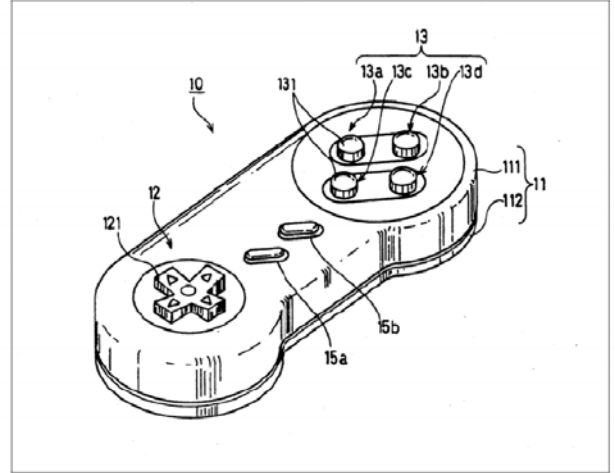
23 _____
24 ⁴ Quintal also argues that Nintendo’s proposed construction relates to
25 “symmetrically” only, and ignores the term “arranged.” Pl.’s Opp’n, Dkt. 49 at 7, 19. But
26 the dictionary definition of “arranged” cited by Quintal demonstrates that “arranged” refers
to the “relationship” between the two thumb controls. *Id.* at 19. “Symmetrically” indicates
how the thumb controls are related to one another.

27 ⁵ The ‘944 Patent’s effective date is based on that of the parent patent. *See Hill-*
28 *Rom Services, Inc. v. Stryker Corp.*, 755 F.3d 1367, 1385 (Fed. Cir. 2014) (“the patents-in-
suit claim priority to an application filed in 1993 and, a proper construction of the claims
must be tethered to that date.”).

App. No. 12/980,620, Dkt. 50-5 at ¶ [0087] (four buttons and analog stick are “placed symmetrically to each other”). In contrast, the ’944 Patent does not claim a group of symmetrically arranged buttons or controls. Instead, the ’944 Patent specifically claims “two spaced thumb controls [that] are symmetrically arranged on each side of the display screen.”

Quintal also cites a Nintendo patent filing in 1991, U.S. Patent No. 5,207,426 (‘426 Patent’), for a handheld game controller. Pl.’s Opp’n, Dkt. 49 at 15.

According to Quintal, this patent is significant because it purportedly shows that Nintendo allegedly “treats the four button cluster singularly as one unit of four



buttons. . .” Dkt. 49 at 14-15 (emphasis in orig.). Not so. Neither the claims nor specification of the ‘426 Patent recites this—nor do they make any mention of the term “symmetrically.” As such, Quintal is hard pressed to claim that the ‘426 Patent supports the notion that “symmetrically” as used in the ‘944 Patent only refers to the location of the buttons, as opposed to their size, shape and location.

As an ancillary matter, Quintal argues that Nintendo should be judicially estopped from claiming that “symmetrically arranged” means the size, shape and location of controls on the ground that Nintendo purportedly took the opposite position during the prosecution of its own patents. Dkt. 49 at 28. Judicial estoppel is a discretionary doctrine that may be applied upon consideration of the following factors: (1) whether the party’s new assertion is clearly inconsistent with its earlier position; (2) whether the party was successful in persuading the earlier court to follow his first position, such that the finding of the earlier court would now be incorrect and one court or the other appears to be misled in a finding; and (3) whether the party asserting inconsistent positions would derive an unfair advantage or impose an unfair detriment if not estopped. New Hampshire v. Maine, 532 U.S. 742,

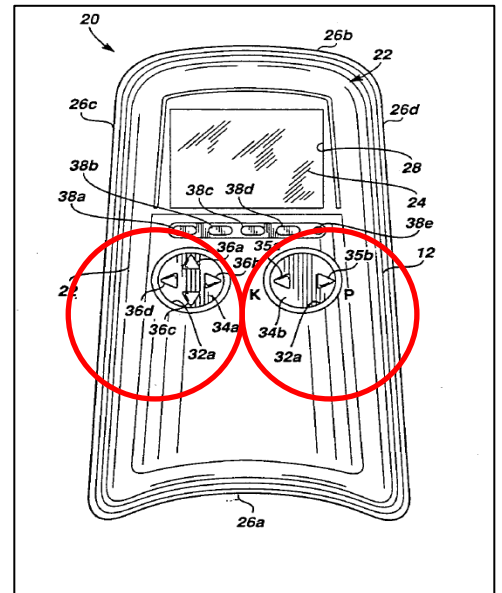
748 (2001). Applying this test, the Court, in its discretion, finds that judicial estoppel is not warranted. First, Nintendo's position in this litigation is not inconsistent with the prosecution of its patents. Second, the text from the patent specifications quoted by Quintal do not show that Nintendo took any "position" or otherwise persuaded the PTO to interpret any particular claim terms in any particular manner. Finally, Quintal has made no showing that Nintendo gained any unfair advantage by having taken any particular position during the patent prosecution process.

Quintal also cites a non-Nintendo patent assigned to Konami Co., Ltd., i.e., U.S. Patent No. 5,137,277 ("Konami Patent"), filed on January 26, 1990, for a Hand Held Video Game With Simulated Air Battle. Martinez Decl. Ex. 12, Dkt. 52-4. In particular, Quintal points to language in the patent specification that "buttons 34a and 34b may optionally be symmetrically located about the longitudinal center line of the casing 22, as shown."

Konami Patent, col. 3, ll. 1-4. However, the term "symmetrically located" does not appear in the patent claim. Accordingly, the fact that

"symmetrically located" is mentioned in the specification is ultimately immaterial to the scope of the patent. Innova/Pure Water, Inc. v. Safari Water Filtration Sys., 381 F.3d 1111, 1115 (Fed. Cir. 2004)

("the claims of a patent define the invention to which the patentee is entitled the right to exclude."). In any event, the graphical depiction of the preferred embodiment shows that the "symmetrically located" buttons are indeed mirror images of each other, which supports Nintendo's position in this action.



c) *Quintal's Expert Declaration*

Finally, Quintal relies on the declaration of its expert, John Wharton ("Wharton"), to support its contention that "symmetrically arranged" only refers to positional symmetry. Extrinsic evidence in the form of expert testimony can be useful in a variety of areas,

1 including whether a “particular term in the patent or the prior art has a particular meaning
2 in the pertinent field.” Phillips, 415 F.3d at 1318. Conversely, “conclusory, unsupported
3 assertions by experts as to the definition of a claim term are not useful to a court.” Id.
4 Similarly, a court should discount any expert testimony “that is clearly at odds with the
5 claim construction mandated by the claims themselves, the written description, and the
6 prosecution history, in other words, with the written record of the patent.” Key Pharm. v.
7 Hercon Lab. Corp., 161 F.3d 709, 716 (Fed. Cir. 1998); see also Trilogy Comm’n, Inc. v.
8 Times Fiber Comm’n, Inc., 109 F.3d 739, 744 (Fed. Cir. 1997) (“When, as here, the
9 district court has concluded that the patent specification and the prosecution history
10 adequately elucidate the proper meaning of the claims, expert testimony is not necessary
11 and certainly not crucial.”).

12 In his declaration, Wharton states: “There is no value in having ‘mirror image’
13 symmetry of individual buttons such that they are symmetrical in size, shape, and location,
14 and as one skilled in the art, it is my opinion that the term, [sic] symmetrically arranged on
15 each side of the center line of the display screen refers to the general locations of the
16 controls.” Wharton Decl. ¶ 15, Dkt. 49-1. This opinion is entirely conclusory and contrary
17 to the intrinsic evidence. See Karlin Tech., Inc. v. Surgical Dynamics, Inc., 177 F.3d 968,
18 971 (Fed. Cir. 1999) (“The court may receive extrinsic evidence to educate itself about the
19 invention and the relevant technology, but the court may not use extrinsic evidence to
20 arrive at a claim construction that is clearly at odds with the construction mandated by the
21 intrinsic evidence”). Most notably, Wharton completely fails to address the ’944 Patent’s
22 claim language, specification, or prosecution history.⁶ The Court therefore affords little
23 weight to Wharton’s declaration regarding the meaning of “symmetrically arranged.”

24 _____
25 ⁶ The Court disagrees with the Wharton’s suggestion that there is “no value” in
26 having each thumb control button be the mirror image of the other. The specification
27 makes clear that the microdeck is intended to be a handheld device operated with both
28 hands of the user—with the top perimeter controls operated by the user’s fingers, and the
bottom and face-mounted controls operated by the user’s thumbs. The specification
indicates that the thumb controls must be operable in both redundant and tandem modes.
Given that the left and right thumb controls must operate in that manner, as well as be
ergonomic, it makes logical sense that they are mirror images of one another.

d) Conclusion

In sum, the Court finds that the intrinsic evidence and extrinsic evidence support the conclusion that the limitation in Claims 1 and 9 that “two spaced thumb controls are symmetrically arranged on each side of the center line of the display screen” means “two spaced thumb controls corresponding in size, shape and position on each side of the centerline of the display screen.” The Court now turns to the second part of its analysis, which addresses whether the accused devices, i.e., the Game Boy Advance and the Game Boy Micro, infringe those claims.

B. INFRINGEMENT ANALYSIS

Patent infringement may be proven by direct or literal infringement, or under the doctrine of equivalents. Gen. Elec. Co. v. Int’l Trade Com’n, 670 F.3d 1206, 1214 (Fed. Cir. 2012). Quintal alleges both theories of patent infringement, which are addressed below.

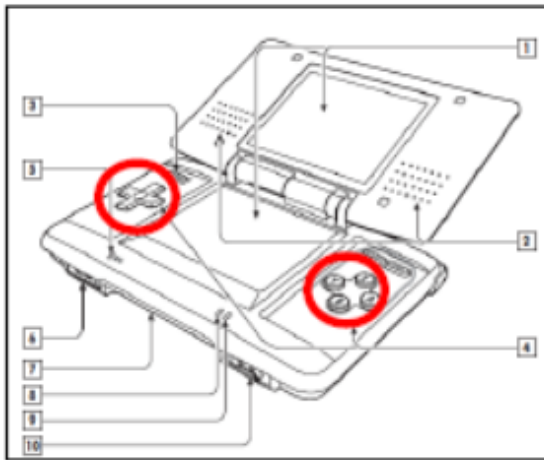
1. Direct Infringement

“Direct infringement requires proof by preponderant evidence that the defendant . . . uses (if a product claim) each element of a claim, either literally or under the doctrine of equivalents.” Cheese Sys., Inc. v. Tetra Pak Cheese & Powder Sys., Inc., 725 F.3d 1341, 1348 (Fed. Cir. 2013). A claim is “literally infringed” if each properly construed claim element directly reads on the accused product or process. Jeneric/Pentron Inc. v. Dillon Co., 205 F.3d 1377, 1382 (Fed. Cir. 2000). If any claim limitation is absent from the accused device, there is no literal infringement as a matter of law. Amgen Inc. v. F. Hoffman-LA Roche Ltd., 580 F.3d 1340, 1374 (Fed. Cir. 2009). “[A] literal infringement issue is properly decided upon summary judgment when no genuine issue of material fact exists, in particular, when no reasonable jury could find that every limitation recited in the properly construed claim either is or is not found in the accused device.” Bai v. L & L Wings, Inc., 160 F.3d 1350, 1353 (Fed. Cir. 1998).

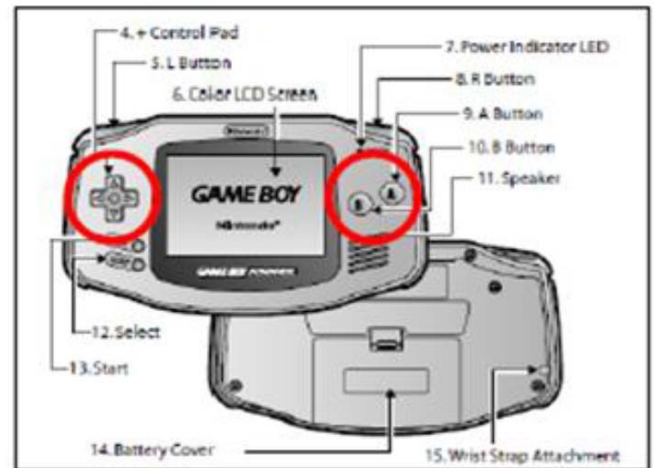
The Court has construed the claim limitation “two spaced thumb controls are symmetrically arranged on each side of the center line of the display screen” to mean “two

spaced thumb controls corresponding in size, shape and position on each side of the centerline of the display screen.” As shown in the depictions of the Game Boy Advance, Game Boy Micro and Game Boy DS (shown below), each device contains a cross-shaped button mounted on the left side of the centerline of the display screen, and two or more staggered buttons on the right. See Hamilton Decl. Exs. H, L. As such, the buttons located on the left and right sides of the display screen do not correspond in shape, size or position on each side of the centerline of the display screen, and hence, do not infringe Claims 1 or 9 of the ‘944 Patent.

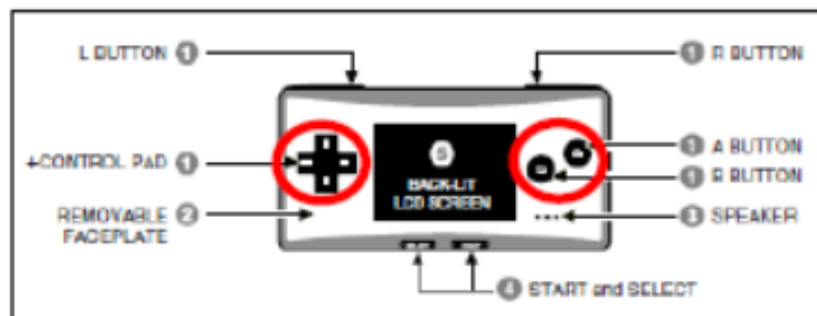
NINTENDO DS



GAME BOY ADVANCE



GAME BOY MICRO



1 Quintal contends that Nintendo's emphasis that the Game Boy devices have buttons
2 of different shapes and sizes on either side of the display screen is a "red herring" because
3 "the clusters of controls remain symmetrically arranged." Pl.'s Opp'n, Dkt. 49 at 21-22
4 (emphasis added). However, the patent claims at issue require "two spaced thumb controls
5 mounted on the front of the pocketsize unit. . . . wherein the . . . two spaced thumb controls
6 are symmetrically arranged on each side of the display screen." '944 Patent, col. 18 ll. 26-
7 28 (emphasis added). The claims do not recite or otherwise relate to symmetrically
8 arranged "groups" or "clusters of controls." Thus, to meet the limitations recited in Claims
9 1 and 9, Quintal must identify at least one thumb control on the left side of the console that
10 is "symmetrically arranged" with at least one thumb control on the right side. Thus, even if
11 Quintal were correct that "symmetrically arranged" means only locational symmetry, the
12 accused devices still would not infringe Claims 1 and 9, which explicitly teach the use of
13 two thumb-operated buttons—not multiple buttons on each side of the display screen.

14 2. Doctrine of Equivalents

15 Where an accused device does not literally infringe, a patentee may prove
16 infringement under the doctrine of equivalents. Kemco Sales, Inc. v. Control Papers Co.,
17 208 F.3d 1352, 1364 (Fed. Cir. 2000). Under this doctrine, infringement may be found
18 only "if every limitation of the asserted claim, or its 'equivalent,' is found in the accused
19 subject matter, where an 'equivalent' differs from the claimed limitation only
20 insubstantially." Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp., 149 F.3d 1309, 1315
21 (Fed. Cir. 1998). "An element in the accused product is equivalent to a claim limitation if
22 the differences between the two are 'insubstantial' to one of ordinary skill in the art."
23 Eagle Comtronics, Inc. v. Arrow Commc'n Labs., Inc., 305 F.3d 1303, 1315 (Fed. Cir.
24 2002). To oppose a defendant's motion for summary judgment of non-infringement under
25 the doctrine of equivalents, the plaintiff has the burden of producing "particularized
26 testimony and linking argument on a limitation-by-limitation basis that create[s] a genuine
27
28

issue of material fact as to equivalents.” AquaTex Indus., Inc. v. Techniche Solutions, 479 F.3d 1320, 1328-29 (Fed. Cir. 2007).⁷

a) Prosecution History Estoppel

Nintendo contends that Quintal is estopped from relying on the doctrine of equivalents on the ground that, during the patent prosecution process, the “symmetrically arranged” language was added as a narrowing amendment to avoid prior art. “The doctrine of prosecution history estoppel bars a patentee from asserting as an equivalent subject matter surrendered during prosecution of the patent application.” Eagle Comtronics, 305 F.3d at 1316.⁸ If a claim is narrowed for any reason related to patentability, “the inventor is deemed to concede that the patent does not extend as far as the original claim.” Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, 737-38 (2002); Glaxo Wellcome, Inc. v. Impax Labs., Inc., 356 F.3d 1348, 1352 (Fed. Cir. 2004) (stating that if a claim is so narrowed, it is presumed “that the patentee surrendered the territory between the original claims and the amended claims”).

“The first question in a prosecution history estoppel inquiry is whether an amendment filed in the Patent and Trademark Office [] has narrowed the literal scope of a claim. If the amendment was not narrowing, then prosecution history estoppel does not apply.” Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 344 F.3d 1359, 1366 (Fed. Cir. 2003) (internal citation omitted). Here, the record shows that the patent examiner added the “symmetrically arranged” limitation due to his concern that the ‘944 Patent would be deemed anticipated or obvious in light of the prior art. He noted that the newly-

⁷ A court may determine infringement on summary judgment when no reasonable jury could find that every limitation recited in the properly construed claim either is or is not found in the accused device. EMD Millipore Corp. v. AllPure Techs., Inc., 768 F.3d 1196, 1200-201 (Fed. Cir. 2014).

⁸ The Federal Circuit has “recognized that prosecution history estoppel can occur . . . in one of two ways, either (1) by making a narrowing amendment to the claim (‘amendment-based estoppel’) or (2) by surrendering claim scope through argument to the patent examiner (‘argument-based estoppel’).” Conoco, Inc. v. Energy & Env’tl. Int’l, L.C., 460 F.3d 1349, 1363 (Fed. Cir. 2006). Nintendo’s argument is predicated upon amendment-based estoppel.

1 added “symmetrically arranged” limitation was among “key features of the claimed
2 invention that are not taught or fairly suggested by the prior art.” Hamilton Decl., Ex. B,
3 Dkt. 45-7 at 7. Notably, the examiner pointed out that the “closest prior art Matthews
4 (5,432,510) teaches [a] data input device [that] includes an ergonomic arrangement of keys
5 on [a] casing”—but that the Matthews reference, whether considered individually or in
6 combination of other prior art, did not read on the specified limitations, as amended. Id. In
7 other words, the examiner deemed it necessary to add the “symmetrically arranged”
8 limitation to narrow the claims in order to avoid any potential anticipation or obviousness
9 issues.⁹

10 Quintal argues that subsequent findings made by the examiner prove that the claims
11 were not narrowed. As noted, after the examiner amended the inventor’s claims and issued
12 the Notice of Allowance, the inventor submitted an Amendment After Allowance in which
13 he sought to correct a typographical error and add a clarification that the finger and thumb
14 controls must be symmetrically arranged on each side “of the centerline” of the display
15 screen. Hamilton Decl. Ex. C, Dkt. 45-8. After the examiner and inventor discussed the
16 matter by telephone, the examiner concluded that the “[the Amendment After Allowance]
17 is proper and is not effected [sic] the scope of the invention.” Martinez Decl. Ex. 13, Dkt.
18 52-5 at 3. Quintal seizes upon the examiner’s comment that the claims were “not effected”
19 as proof that the examiner’s addition of “symmetrically arranged” did not narrow the patent
20 claims. Pl.’s Opp’n, Dkt. 49 at 6. This contention lacks merit. In making that remark, the
21 examiner was referring to the effect of the inventor’s proposed amendment in the
22 Amendment After Allowance, not his (the examiner’s) original amendment as set forth in
23 the Notice of Allowance. Thus, the Court rejects Quintal’s contention that the amendment
24 was not narrowing.

25
26 ⁹ Quintal claims that the examiner’s amendment was “not made to overcome
27 rejection base on the Matthews patent” Dkt. 49 at 22. As set forth above, the Court
28 disagrees with that assertion. But whether or not the amendment was made in response to a
particular prior art reference is inapposite. The salient question is whether the amendment
was made to secure patentability.

1 Having concluded that the amendment was narrowing, the Court turns to the next
2 inquiry, which “is whether the reason for that amendment was a substantial one relating to
3 patentability.” Festo, 344 F.3d at 1366-67. “When the prosecution history record reveals
4 no reason for the narrowing amendment, [the law] presumes that the patentee had a
5 substantial reason relating to patentability; consequently, the patentee must show that the
6 reason for the amendment was not one relating to patentability if it is to rebut that
7 presumption.” Id. at 1366. Quintal argues that the addition of “symmetrically arranged” to
8 Claims 1 and 9 was not intended to avoid rejection under the Matthews prior art reference,
9 but was only intended to “clarify” the patent claims. Dkt. 49 at 22. However, the examiner
10 made a point of stating that the prior art taught “the ergonomic arrangement of keys,” it did
11 not disclose a “pocket-size unit” containing “symmetrically arranged” finger and thumb
12 controls. Hamilton Decl. Ex. C, Dkt. 45-7 at 7. Under Quintal’s reading of the Notice of
13 Allowance, the examiner’s findings would be superfluous.

14 Finally, “[if] the court determines that a narrowing amendment has been made for a
15 substantial reason relating to patentability . . . then the third question in a prosecution
16 history estoppel analysis addresses the scope of the subject matter surrendered by the
17 narrowing amendment.” Festo, 344 F.3d at 1367. Quintal claims that Nintendo has failed
18 to address this inquiry. But it is presumed “that the patentee has surrendered all territory
19 between the original claim limitation and the amended claim limitation,” unless the
20 patentee can rebut the presumption of total surrender. Id. In this case, the subject matter
21 surrendered as a result of the amendment is the required design insofar as the finger and
22 thumb controls are concerned, which now must be “symmetrically arranged.” Accordingly,
23 the Court is persuaded that the doctrine of prosecution history estoppel precludes Quintal
24 from relying on the doctrine of equivalents in this action.

25 ***b) Merits***

26 Even if it were not precluded from claiming infringement under the doctrine of
27 equivalents, Quintal has failed to make a sufficient showing of equivalence to survive
28 summary judgment. “To find infringement under the doctrine of equivalents, any

1 differences between the claimed invention and the accused product must be insubstantial.”
 2 Virnetx, Inc. v. Cisco Systems, Inc., 767 F.3d 1308, 1322 (Fed. Cir. 2014).

3 “Insubstantiality may be determined by whether the accused device performs substantially
 4 the same function in substantially the same way to obtain substantially the same result as
 5 the claim limitation.” Id. (emphasis added). Thus, where the moving party has
 6 demonstrated its entitlement to summary judgment of no literal infringement, the plaintiff
 7 then has the burden of producing “particularized testimony and linking argument on a
 8 limitation-by-limitation basis that create[s] a genuine issue of material fact as to
 9 equivalents.” AquaTex Indus., Inc. v. Techniche Solutions, 479 F.3d 1320, 1328-29 (Fed.
 10 Cir. 2007) (affirming grant of summary judgment of non-infringement where plaintiff
 11 failed to demonstrate a genuine issue of material fact under the doctrine of equivalents by
 12 only providing lawyer argument and generalized testimony about the accused product).

13 Quintal argues that the buttons on the accused devices perform the same function—
 14 i.e., “data input or game playing via button depressing”—as the claimed symmetrically
 15 arranged controls. However, this function bears no relation to the limitation at issue, since
 16 any “two spaced thumb controls” would perform Quintal’s proposed function irrespective
 17 of how the buttons are arranged, effectively writing “symmetrically” out of the claim.
 18 Moreover, Quintal has failed to proffer “particularized testimony and linking argument as
 19 to the insubstantiality of the differences between the claimed invention and the accused
 20 device or process, or with respect to the ‘function, way, result’ test” Am. Calcar, Inc.
 21 v. Am. Honda Motor Co., Inc., 651 F.3d 1318, 1338-39 (Fed. Cir. 2011). The expert
 22 testimony presented by Quintal in this regard is entirely conclusory and is insufficient to
 23 create a question of fact under the doctrine of equivalents. Id. (“generalized testimony as to
 24 the overall similarity between the claims and the accused infringer’s product from one of
 25 the inventors does not suffice to create a genuine issue of material fact.”).¹⁰ The Court

26
 27 ¹⁰ Quintal’s expert, John Wharton, states: “Even if the components within the
 28 symmetrically arranged controls were not the same size and shape, they would nonetheless
 perform substantially the same function in substantially the same way to obtain the same
 result.” Wharton Decl. ¶ 21, Dkt. 49-1.

1 therefore finds that Quintal has failed to raise a material question of fact as to whether
2 Nintendo's accused Game Boy devices infringe under the doctrine of equivalents.

3 **C. RULE 56(D) REQUEST**

4 In a footnote, Quintal seeks a continuance of the instant motion, see Pl.'s Opp'n,
5 Dkt. 49 at 23 n.8, pursuant to Federal Rule of Civil Procedure 56(d), which allows a court
6 to defer consideration of a summary judgment motion where "a nonmovant shows by
7 affidavit or declaration that, for specified reasons, it cannot represent facts essential to
8 justify its opposition." To obtain relief under this rule, "[t]he requesting party must show:
9 (1) it has set forth in affidavit form the specific facts it hopes to elicit from further
10 discovery; (2) the facts sought exist; and (3) the sought-after facts are essential to oppose
11 summary judgment." Family Home & Fin. Ctr., Inc. v. Fed. Home Loan Mortg. Corp., 525
12 F.3d 822, 827 (9th Cir. 2008). The "[f]ailure to comply with these requirements is a proper
13 ground for denying discovery and proceeding to summary judgment." Id. (internal
14 quotation marks omitted). Setting aside that it is improper for a party to present a
15 substantive request in a footnote devoid of any meaningful analysis, see City of Emeryville
16 v. Robinson, 621 F.3d 1251, 1261 n.9 (9th Cir. 2010), Quintal has otherwise failed to make
17 the requisite showing for a Rule 56(d) request, which is therefore denied.


18 **IV. CONCLUSION**

19 For the reasons set forth above,

20 IT IS HEREBY ORDERED THAT Defendants' Motion for Summary Judgment is
21 GRANTED. The Clerk shall close the file and terminate all pending matters.

22 IT IS SO ORDERED.

23 Dated: July 17, 2015

24 
SAUNDRA BROWN ARMSTRONG
25 United States District Judge
26
27
28